

Remarks

In the present RCE, three claims (11, 12, 15) are amended; nine claims (16-24) are newly added. Claims 1-10 and 14 are canceled. Claims 11-13 and 15-24 are presented for examination. No new matter is added.

I. Claim Rejections: 35 USC § 102

Claims 1, 4 – 7, and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by “1.2 GB Firmware Utility” developed by Apple Computer, Inc (hereafter, Apple). These claims are canceled, and this rejection is moot.

II. Claim Rejections: 35 USC § 102

Claims 1, 10, 11, 14, and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by USPN 5,930,553 (Hirst). Applicant respectfully traverses.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Hirst neither teaches nor suggests each element in the rejected claims, these claims are allowable over Hirst.

Claim 11

Claim 11 recites numerous limitations that are not taught or suggested in Hirst. For example, claim 11 recites a print cartridge having an upgrade version of program code for a **host computer** that is communication with the print cartridge. By contrast, Hirst expressly teaches downloading upgrades from the print cartridge to microcontrollers in the printer or office automation equipment, not a host computer. Applicant cites several locations in Hirst:

Additionally, it would be advantageous to be able to provide software patches and updates to the **office automation and image forming devices**. (Emphasis added: 2: 23-25).

While this representation is indicative of a laser type printer it should be understood that the invention is not so limited and is applicable to **other image forming devices and office automation devices** such as facsimile machines, thermal printers, impact printers, ink jet printers and virtually any other kind of device which uses expendable components to create the images. (Emphasis added; 4: 10-17).

However, should it become necessary or desirable to update the instructions for a microcomputer 30, a software patch stored in memory segment 19e of consumable memory device 19 can be uploaded into EEPROM 33. (5: 54-57).

Thus, Hirst does not teach or suggest a print cartridge having an upgrade version of program code for a **host computer** that is communication with the print cartridge.

For at least these reasons, claim 11 and its dependent claims are allowable over Hirst.

III. Claim Rejections: 35 USC § 103

Claims 12 is rejected under 35 USC § 103 as being unpatentable over Hirst in view of "1.2 GB Firmware Utility" developed by Apple Computer, Inc (Apple). Apple fails to cure the deficiencies of Hirst. Thus, for at least the reasons given in connection with independent claim 11, dependent claim 12 is allowable over Hirst and Apple.

IV. Claim Rejections: 35 USC § 103

Claims 8 is rejected under 35 USC § 103 as being unpatentable over Apple in view of USPN 5,878,256 (Bealkowski). Claim 8 is canceled, and this rejection is moot.

V. Claim Rejections: 35 USC § 103

Claims 13 is rejected under 35 USC § 103 as being unpatentable over Hirst in view of Bealkowski. Bealkowski fails to cure the deficiencies of Hirst. Thus, for at least the reasons given in connection with independent claim 11, dependent claim 13 is allowable over Hirst and Bealkowski.

VI. New Claims

New claims 16-24 recite numerous limitations that are not taught or suggested in the art of record. By way of example, claim 16 recites “determining if a host computer, in communication with the print cartridge, requires an upgrade; and if the host computer requires the upgrade, then downloading the code from the print cartridge to the host computer.”

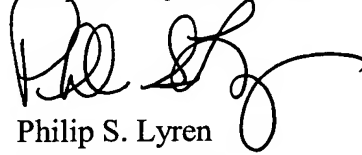
CONCLUSION

In view of the above, Applicant believes all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,



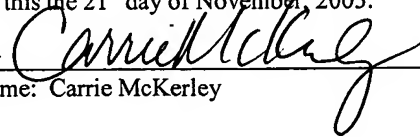
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CERTIFICATE UNDER 37 C.F.R. 1.10

The undersigned hereby certifies that this paper or papers, as described herein, is being deposited with the United States Postal Service 'Express Mail Post Office to Addressee' service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, Alexandria VA 22313-1450 on this the 21st day of November, 2005.

By

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